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RE: 01017/40451C

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Dated: February 22, 2006 Signature: (Sharon M. Sirich)

Docket No.: 9191 (A-947C)
01017/40451C

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Brockhaus et al.

Confirmation No.: 5613

Application No.: 08/444,791

Art Unit: 1644

Filed: May 19, 1995

Examiner: R. Schwadron

For: HUMAN TNF RECEPTOR

RESPONSE TO RESTRICTION REQUIREMENT WITH TRAVERSE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is a response to the Restriction Requirement mailed January 25, 2006. The Examiner required an election of one of the following peptide sequence species: SEQ ID NO: 8, SEQ ID NO: 10 or SEQ ID NO: 12. Applicants hereby elect the species of SEQ ID NO: 12 for continued examination, with traverse.

Traversal of the Species Restriction

All pending claims are directed to polynucleotides comprising a nucleic acid subsequence that encodes a soluble fragment of an insoluble TNF receptor protein. Therefore, the sequences of the encoded proteins encompassed by all the pending claims derive from the sequence of the 75 kD TNF receptor and the Examiner would have to search the entirety of the 75 kD TNF receptor sequence regardless of the peptide elected. Thus, examination of claims reciting any of the three peptide species, all of which are included in the 75 kD TNF receptor sequence, is not an undue burden on the Examiner. Applicants request that the species of SEQ ID NOS: 8, 10 and 12 be examined simultaneously and that the species restriction requirement be withdrawn.

Traversal of the Restriction of Inventions I and II

Claims 125, 127-130, 132-138, 140-145, 147-149, 155-157, 166-168, 177-183 and 196-199 are directed to polynucleotides, host cells and vectors (Invention I), which were the originally claimed invention. Claims 158-165, 169-176, 184-195, and 200-203 are directed to methods of making a protein (Invention II). According to the Examiner, Applicants have constructively elected Invention I by originally presenting this invention for prosecution on the merits.

Applicants traverse the restriction of Inventions I and II. The methods of Invention II use the polynucleotide products of Invention I to make a protein. As the method claims depend from the polynucleotide product claims and the method claims share all the product claim limitations, simultaneous examination of Inventions I and II would not be an undue burden on the Examiner. Applicants therefore request that the claims of Inventions I and II be examined simultaneously and the restriction requirement be withdrawn.

Moreover, if the polynucleotides of Invention I (product claims) are found novel and non-obvious under 35 U.S.C. §103(a), Applicants are entitled to rejoinder of claims to methods of using that product. *See* 1184 OG 86, (1996) and MPEP § 821.04(b). Applicants hereby request that, if the product claims of Invention I are allowed, the Patent Office rejoin the method claims of Invention II.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request that the restriction requirement be withdrawn.

Dated: February 22, 2006

Respectfully submitted,

By _____
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